

REMARKS

Applicants have carefully reviewed this Application in light of the response to the Final Office Action mailed January 26, 2004 and Advisory Action mailed April 15, 2004. Applicants respectfully request that this Request for Continued Examination be considered by the Examiner. Applicants have amended Claims 1, 16, and 19. Applicants submit that no new matter has been added with these amendments. Applicants submit that the pending claims are patentably distinguishable over the cited references. Applicants, therefore, respectfully request reconsideration and favorable action in this case.

Allowed Claim

Applicants note with appreciation the allowance of Claim 11.

Section 102 Rejection

The Office Action rejects Claims 1, 3-4, 6, 16 and 19 under 35 U.S.C. § 102(b) as being anticipated by Ester, et al. (PCT Pub. WO 98/47255) ("*Ester*"). The Office Action rejects Claims 1, 3-4, 6, 16 and 19 under 35 U.S.C. § 102(e) as being anticipated by Thompson (U.S. Patent 6,249,510 B1) ("*Thompson*"). Applicants respectfully traverse all rejections and assertions therein.

A prior art reference anticipates a claim "only if *each and every element* as set forth in the claim is found, either expressly or inherently described," in that reference. *Verdegaal Bros. v. Union Oil Co.*, 814 F.2d 628, 631 (Fed. Cir. 1987) (emphasis added); *see also* M.P.E.P. § 2131 (quoting *Verdegaal Bros.*, 814 F.2d at 631); *see also* M.P.E.P. § 706.02 ("[F]or anticipation under 35 U.S.C. § 102, the reference must teach *every aspect* of the claimed invention either explicitly or impliedly."). In addition, "[t]he identical invention must be shown in as complete detail as is contained in the . . . claims" and "[t]he elements must be arranged as required by the claim." *Richardson v. Suzuki Motor Co.*, 9 USPQ 2d 1913, 1920 (Fed. Cir. 1989); *In re Bond*, 15 USPQ 2d 1566 (Fed. Cir. 1990); MPEP § 2131 (*emphasis added*). Neither *Ester* nor *Thompson* teach each and every element as claimed.

For example, amended Independent Claim 1 recites the following:

"a first portion operable to cause one of the component signals from the optical input terminal to be routed to said further terminal; and
a second portion operable to cause a component signal present at said further terminal to be included in the optical output terminal."

As can be seen from the excerpt above, Applicants have amended Claim 1 to recite that a component signal may be dropped to *and* added from the further terminal. The Examiner appears to indicate that such an amendment would place Claim 1 in a condition of allowance. Advisory Action, Page 2. Further, Applicants reiterate the arguments asserted in the response to the Final Office Action. Regarding *Ester*, the cited output fiber 54 is not "the optical input terminal" as claimed. In particular, output fiber 54 carries only a single wavelength,¹ not "a plurality of optical component signals which are different" as claimed. Regarding *Thompson*, the cited output path 60-2 disclosed in *Thompson* is not "the optical input terminal" as claimed. In particular, the output path 60-2 carries only a single wavelength λ_1 ,² not "a plurality of optical component signals which are different" as claimed. For at least these reasons, Applicants respectfully request reconsideration and allowance of Claim 1 and its dependents 3-4 and 6. Further, Claims 16 and 19 contain limitations similar to those of Claim 1 discussed above and thus are allowable for analogous reasons.

Section 103 Rejection

The Office Action rejects Claims 2, 5, 7, 9-10, 17-18 and 20 under 35 U.S.C. § 103(a) as being unpatentable over *Thompson* in view of *Meli* (U.S. Patent 5,956,319) ("*Meli*"). The Office Action rejects Claims 8 and 15 under 35 U.S.C. § 103(a) as being unpatentable over *Ester* in view of *Cao* (U.S. Patent 6,337,755 B1) ("*Cao*") and in view of *Arecco* (U.S. Patent 6,400,476 B1). The Office Action rejects Claims 12-14 under 35 U.S.C. § 103(a) as being unpatentable over *Ester* in view of *Arecco, et al.* (U.S. Patent 5,903,371) ("the '371 Patent"). Applicants traverse these rejections and all findings and assertions therein. In particular, these depend from independent Claim 1, 16, and 19. As discussed above, independent Claim 1, 16, and 19 are allowable over *Ester* and *Thompson*. The Office Action fails to cite teaching or suggestion in *Meli*, *Cao*, *Arecco*, and *Arecco, et al* of the missing elements discussed above. Thus, Applicants respectfully request that these rejections be withdrawn.

¹ *Ester*, Page 12, Lines 26-27.

² *Thompson*, Figure 2; Col. 4, Lines 46-54.

The Office Action rejects Claims 21 and 22 under 35 U.S.C. § 103(a) as being unpatentable over *Thompson* in view of *Arecco, et al.* Applicants traverse these rejections and all findings and assertions therein.

Applicants reiterate the arguments asserted in the response to the Final Office Action. For example, Claim 21 recites, "a splitter coupled to the demultiplexer, the splitter operable to drop a signal including a plurality of component signals and to supply the signal to the demultiplexer." For the teaching of this limitation, the Office Action offers the optical coupler 32. But Applicants submit that the Office Action fails to consider each and every word of Claim 21. In judging the patentability of Claim 21, the Office Action fails to consider at least "the splitter operable ... to supply the signal to the demultiplexer." The optical coupler 32 (and 31) disclosed in *Arecco, et al.* "are wavelength-selective couplers adapted to separate telemetry signals, with a predetermined telemetry wavelength external to the telecommunication band, towards respective outputs 31a, 32a both connected to a telemetry receiver 50, and signals within the telecommunication band towards the other outputs 31b, 32b." Col. 6, Lines 19-27. Thus, the cited coupler 32 merely drops the telemetry signals and does not "supply the signal to the demultiplexer." Accordingly, Applicants respectfully request reconsideration and allowance of Claim 21 and its dependent Claim 22.

CONCLUSION


Applicants have made an earnest attempt to place this case in condition for allowance. For the foregoing reasons and for other reasons clearly apparent, Applicants respectfully request reconsideration and full allowance of all pending claims.

If the Examiner feels that a telephone conference would advance prosecution of this Application in any manner, the Examiner is invited to contact Brian W. Oaks, Attorney for Applicants, at the Examiner's convenience at (214) 953-6986.

Applicants believe a fee of \$740.00 is due. Enclosed is a check in the amount of \$740.00 to cover said fee. The Commissioner is hereby authorized to charge any extra fees or credit any overpayment to Deposit Account No. 02-0384 of Baker Botts L.L.P.

Respectfully submitted,

BAKER BOTTS L.L.P.
Attorneys for Applicants



Brian W. Oaks
Reg. No. 44,981

Baker Botts L.L.P.
2001 Ross Avenue, Suite 600
Dallas, Texas 75201-2916
(214) 953-6986

Date: April 26, 2004